

Appl. No.: 09/848,519
Amdt. dated 04/04/2006
Reply to Official Action of December 5, 2005

REMARKS/ARGUMENTS

This Amendment is being filed in response to the second non-final Official Action of December 5, 2005. In this regard, the second Official Action rejects Claims 1-20 under 35 U.S.C. § 112, second paragraph, alleging that the claimed invention is indefinite since characterizing findings as strengths or weaknesses in purely subjective. In addition, the second Official Action rejects Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over the publication Susann Wilkinson, *Evaluation Report for Grant #R13 HG00793-0142: Impact of Human Genome Initiative on Society: A Women's Study Approach* (hereinafter "Wilkinson"). As explained below, however, Applicant respectfully submits that the claimed invention is not only definite under § 112, second paragraph, but is also patentably distinct from Wilkinson. Accordingly, Applicant respectfully traverses the rejections of the claims. Applicant has, however, amended independent Claims 1 and 15 to remove recitations previously added thereto in response to the first Official Action. In view of the amendments to independent Claims 1 and 15, and the remarks presented herein, Applicant respectfully requests reconsideration and allowance of all of the claims of the present application.

A. Amendments to Claims 1 and 15

With respect to the amendments to independent Claims 1 and 15, Applicant notes that the first Official Action rejected method Claims 1-6 and 15-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. More particularly, the first Official Action asserted that for a claim to be directed to statutory subject matter, the subject invention (a) must be within the technological arts, and (b) must produce a useful, concrete and tangible result. And although the first Official Action conceded that the subject invention produces a useful, concrete and tangible result, the first Official Action alleged that Claims 1-6 and 15-20 do not apply, involve, use or advance the technological arts since all of the recited steps may be performed manually. In response, Applicant amended independent Claims 1 and 15 to further recite that the voting step occurs electronically via a processor adapted to process a plurality of votes resulting therefrom. Since Applicant's response to the first Official Action, the Board of Patent Appeals and Interferences issued an opinion rejecting the aforementioned "technological arts" test for

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patentable subject matter. *Ex Parte Lundgren*, Appeal No. 2003-2088 (Bd. Pat. App. & Inter. 2005). Accordingly, Applicant has amended independent Claims 1 and 15 to remove the previously added recitation directed to the processor adapted to process the votes. And in view of the Board's decision in *Ex Parte Lundgren*, Applicant respectfully submits that, even without the aforementioned feature, Claims 1-6 and 15-20 are directed to statutory subject matter.

B. Claims 1-20 are Definite under § 112, Second Paragraph

According to one aspect of the claimed invention, as embodied in independent Claim 1 and similarly independent Claims 7 and 15, a method for assessing a process of an organization includes acquiring information concerning the organization and the process. A plurality of preliminary findings (see, e.g., FIG. 4, reference 26) is then developed based upon the information, where each preliminary finding is characterized as a strength or weakness (see, e.g., FIG. 4, reference 30). Next, an electronic vote for agreement or disagreement with each preliminary finding is taken (see, e.g., FIG. 4, reference 32), or as recited in independent Claim 15, an electronic vote of agreement or disagreement with the characterization of each of the preliminary findings is then taken (see, e.g., FIG. 4, reference 34). Thereafter, a plurality of final findings is developed, where each final finding is similarly characterized as a strength or weakness. In this regard, the plurality of final findings is based upon the vote for the conclusion (or valuation in amended independent Claim 15) associated with each preliminary finding.

As indicated above, the second Official Action rejects Claims 1-20 under 35 U.S.C. § 112, second paragraph, alleging that the claimed invention is indefinite since characterizing findings as strengths or weaknesses is purely subjective. In this regard, the second Official Action notes that "what may be a strength to one person may be a weakness to another," and that "[c]haracterizing the findings as a strength or a weakness is purely subjective." Official Action of June 27, 2005, page 2. Applicant respectfully submits, however, that even if one could argue that the terms "strength" and "weakness" are subjective terms, those terms in the context of the claimed invention are definite. *See* MPEP § 2173.02 (explaining that definiteness isn't analyzed in a vacuum, but in light of the specification, the teachings of the prior art, and the interpretation that would be given by those skilled in the art). In this regard, whether a finding is a strength or

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a weakness is outside the scope of the claimed invention. Rather, the claimed invention merely requires that the findings be characterized as strengths or weaknesses. In accordance with the claimed invention, then, it does not matter whether a particular finding is truly a strength or a weakness, only that the finding is characterized as one or the other. And Applicant respectfully submits that defining a characteristic for a finding, or developing a finding having an associated characterization as recited by the claimed invention, is definite under § 112, second paragraph. Accordingly, Applicant also respectfully submits that the rejection of Claims 1-20 under § 112, second paragraph, is overcome.

C. Claims 1-14 are Patentable over Wilkinson

Wilkinson discloses a participant evaluation of a workshop entitled "Women and Genetics in Contemporary Society" (WAGICS). As disclosed, the workshop was evaluated in a number of areas including participant background and expectations, pre- and post-workshop agreement with workshop goals, principles and procedures, assessment of the workshop's individual sessions and the alternative communication techniques, participants' post-workshop commentary and reflection. The evaluation data was collected via pre-and post-workshop participant questionnaires, on-site observations compiled on assessment sheets, and alternative communication techniques such as a suggestion/comment box. In one of the questionnaires, for example, a grid was presented on which participants indicated their agreement or disagreement with the process of organizing the meeting, and the theoretical principles that guided the co-principal investigators and the planning committee responsible for organizing the meeting.

In contrast to independent Claim 1, and similarly independent Claim 7, Wilkinson does not teach or suggest assessing a process of an organization according to a method that includes (a) developing preliminary findings based upon information concerning the organization and the process, where each finding is characterized as either a strength or weakness; (b) electronically voting for agreement or disagreement with each finding (or with the characterization of each finding); and then (c) developing final findings based upon the vote, where the final findings, like the preliminary findings, are each characterized as a strength or weakness (i.e., each final finding includes the characterization).

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The Official Action appears to concede that Wilkinson does not explicitly disclose preliminary or final findings having associated strength or weakness characterizations. Nonetheless, the Official Action alleges that this feature is inherent in Wilkinson since such characterizations are subjective and that, while the theoretical principles presented to the participants for agreement voting mostly include strengths, one or more of those principles may be viewed by some as weaknesses. To the contrary, however, Applicant respectfully submits that not only has the Official Action not established inherency of the aforementioned feature of the claimed invention, Wilkinson does not inherently teach or suggest this feature. In this regard, to establish inherency, evidence must make clear that the missing descriptive matter is necessarily present in the prior art, and would be recognized as being present in the prior art by those skilled in the art. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citing *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991)). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* (citing *Continental Can Co.*, 948 F.2d at 1269) (emphasis added). In the instant case, the Official Action alleges that items of a questionnaire may be viewed as strengths or weaknesses due to the subjectivity of something being viewed as a strength or a weakness. As indicated above, however, the mere fact that items may be viewed as strengths or weaknesses does not itself support Wilkinson inherently disclosing that those items necessarily have associated characterizations as strengths or weaknesses, as required to establish inherency. Applicant therefore respectfully submits that the Official Action has not established that Wilkinson inherently discloses the aforementioned feature of the claimed invention.

In contrast to the allegation of the Official Action, Applicant respectfully submits that nothing in Wilkinson teaches or suggests, explicitly or inherently, that the items of the participant questionnaires are characterized as strengths or weaknesses (i.e., have associated characterizations selected from a group consisting of a strength or a weakness), as recited by the claimed invention. As is well understood by those skilled in the art, characterizations such as those recited by the claimed invention may be considered traits, qualities or properties that at least partially distinguish respective entities from one another. See Merriam-Webster Online

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Dictionary, *Characteristic* (visited Feb. 27, 2006) <<http://www.m-w.com/dictionary/characteristic>> (explaining that characteristics may be defined as distinguishing traits, qualities or properties). In accordance with the claimed invention, then, the recited characterizations at least partially distinguish the findings from one another. Nothing in Wilkinson, however, teaches or suggests that the items of a questionnaire have associated traits, qualities or properties that serve to distinguish the items from one another, much less in any manner that could reasonably be interpreted to correspond to a strength or a weakness.

Applicant therefore respectfully submits that independent Claim 1, and similarly independent Claim 7, is patentably distinct from Wilkinson. And as dependent Claims 2-6 and 8-14 include all the limitations of respective ones of independent Claims 1 and 7, dependent Claims 2-6 and 8-14 are also patentably distinct from Wilkinson for at least the reasons given above. In addition, Applicant respectfully submits that various ones of dependent Claims 2-6, 8-14 and 16-20 recite features further patentably distinct from Wilkinson. For example, dependent Claim 6, and similarly dependent Claim 12, further recites voting for agreement or disagreement with the characterization (strength or weakness) of each preliminary finding (i.e., voting for a valuation), and developing final findings further based upon the aforementioned voting step. As explained above, Wilkinson does not teach or suggest, explicitly or inherently, preliminary or final findings having associated strength or weakness characterizations. Thus, Wilkinson also does not teach or suggest, explicitly or inherently, voting for agreement or disagreement with those characterizations. Moreover, even if one could argue (albeit incorrectly) that Wilkinson inherently discloses that the questionnaire items are inherently characterized as strengths or weaknesses by virtue of the subjective nature of such a characterization, Wilkinson still does not teach or suggest voting for agreement or disagreement with the characterization of findings as strengths or weaknesses, as recited by dependent Claims 6 and 12.

For at least the foregoing reasons, Applicant respectfully submits that Claims 1-14 are patentably distinct from Wilkinson, and that the rejection of those claims as being unpatentable over Wilkinson is overcome.

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D. Claims 15-20 are Patentable over Wilkinson

Similar to independent Claim 1, independent Claim 15 recites a method for developing at least one assessment of a process of an organization, where each of the at least one assessments has an associated characterization selected from a group consisting of a strength and a weakness. Also similar to independent Claim 1, independent Claim 15 recites acquiring information concerning the organization and the process, and developing a plurality of preliminary findings based upon the information, where each preliminary finding has an associated characterization. In addition, similar to dependent Claim 6, independent Claim 15 recites voting for a valuation associated with each preliminary finding, where the valuation is selected from a group consisting of an agreement with the characterization of the preliminary finding and a disagreement with the characterization of the preliminary finding. Further, independent Claim 15 recites developing the assessment(s), where each assessment has an associated characterization based upon the voting for the valuation associated with each preliminary finding.

In contrast to independent Claim 15, Wilkinson does not teach or suggest assessing a process of an organization according to a method that includes developing preliminary findings based upon information concerning the organization and the process, where each finding is characterized as either a strength or weakness, as explained above with respect to independent Claim 1. Also in contrast to independent Claim 15, Wilkinson does not teach or suggest voting for agreement or disagreement with strength or weakness characterizations of the preliminary findings, as explained above with respect to dependent Claim 6. Thus, for at least the same reasons given above with respect to independent Claims 1 and 6, Applicant respectfully submits that independent Claim 15, and by dependency Claims 16-20, is also patentably distinct from Wilkinson. Accordingly, Applicant respectfully submits that the rejection of Claims 15-20 as being unpatentable over Wilkinson is overcome.

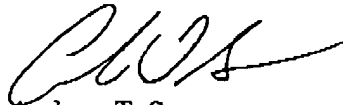
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CONCLUSION

In view of the amendments to the claims and the remarks presented above, Applicant respectfully submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,





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